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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,638	10/31/2003	Tsutomu Matsuzaki	062709-0115	8489
22428 7590 01/17/2007 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			EXAMINER HUSON, MONICA ANNE	
			ART UNIT 1732	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/17/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/697,638

Applicant(s)

MATSUZAKI ET AL.

Examiner

Monica A. Huson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29, 31-33 and 35-37 is/are pending in the application.
- 4a) Of the above claim(s) 1-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-29, 31-33 and 35-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to the Amendment filed 18 October 2006.

Claim Objections

Claims 35 and 37 are objected to because of the following informalities: Claims 35 and 37 appear to be substantial duplicates of claims 31 and 33, respectively. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-18, 20-28, 31-33, and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chomier et al. (U.S. Patent 6,858,276), in view of Fujitani et al. (U.S. Patent 6,019,928). Regarding Claim 16, Chomier et al., hereafter "Chomier," show that it is known to carry out a method for manufacturing a cross member, which is configured to extend in a width direction of a vehicle body and which is configured to have both ends connected to side framework structures of the vehicle body (Abstract; Column 5, lines 47-67), the method comprising the steps of forming, from a material, a base frame extending in the width direction of the vehicle body by means of resinous molding, the base frame being formed to have a substantially circular or oval cross section (Column 3, lines 23-29; Column 5, lines 17-21, 47-67); forming a plurality of bosses on an outer circumferential surface on the base frame within a limited range of the base frame (Column 2, lines 15-23; It is

noted that the location of the bosses is not interpreted as materially affecting the stepwise nature of the claim, specifically the step of “forming a plurality of bosses”. To be entitled to weight in method claims, recited structural limitations must affect the method in a manipulative sense and not amount to mere claiming of a use of a particular structure. *Ex parte Pfeiffer* 135 USPQ 31.); and insert molding the base frame, within limited ranges thereof in the width direction of the vehicle body, in resinous material belonging to a same material system as the material of the base frame, thereby forming reinforcing frame parts integral with the base frame, the reinforcing frame parts being molded to have substantially circular or oval cross sections (Column 3, lines 32-63; Column 4, lines 45-64; Column 5, lines 1-8, 22-28). Chomier does not show accommodating the limited range of the base frame in a molding die wherein the bosses have a height capable of contact the inner surface of the die. Fujitani et al., hereafter “Fujitani,” show that it is known to carry out a method of making a cross member which is configured to extend in a width direction of a vehicle body, including accommodating the limited range of the base frame in a molding die wherein the bosses (Figure 4, element 11) each having a height capable of contacting with the inner surface of the molding die when the molding die is closed (Figure 4, element 14); and forming reinforcing frame parts on the limited range of the base frame by means of insert molding, by filling up a cavity between the outer circumferential of the base frame and the inner surface of the molding die in a manner such that the molten resin flows between each of the plurality of bosses in the cavity (Figure 4, after “→”) whereby the base frame is covered with the reinforcing frame parts (Figure 4, after “→”). Fujitani and Chomier are combinable because they are concerned with a similar technical field, namely, methods of molding automobile components. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Fujitani’s particular

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accommodation step during Chomier's method in order to insure proper fixation of the insert (See Fujitani, column 4, lines 30-39, 50-60).

Regarding Claim 17, Chomier shows the process as claimed as discussed in the rejection of Claim 16 above, including a method wherein the base frame is produced by injection molding (Column 5, lines 16-28).

Regarding Claim 18, Chomier shows the process as claimed as discussed in the rejection of Claim 16 above, including a method wherein the reinforcing frame parts are produced by means of insert molding while inserting part of the base frame into a molding die (Column 4, lines 45-64; Column 5, lines 1-8).

Regarding Claim 20, Chomier shows the process as claimed as discussed in the rejection of Claim 16 above, including a method wherein the base frame and the reinforcing frame parts are made from same engineering material or plural engineering plastic materials belonging to the same material system (Column 5, lines 22-27).

Regarding Claim 21, Chomier shows the process as claimed as discussed in the rejection of Claim 20 above, including a method wherein the base frame is made from resinous material containing a reinforcing material (Column 5, lines 17-46).

Regarding Claim 22, Chomier shows the process as claimed as discussed in the rejection of Claim 20 above, including a method wherein the reinforcing frame parts are made from resinous material containing a reinforcing material (Column 5, lines 22-46).

Regarding Claim 23, Chomier shows the process as claimed as discussed in the rejection of Claim 16 above, including a method wherein the base frame has a hollow part to serve as part of an air conditioning duct (Column 5, lines 47-67).

Regarding Claim 24, Chomier shows the process as claimed as discussed in the rejection of Claim 21 above, including a method wherein the reinforcing material contains glass fiber (Column 5, lines 29-32).

Regarding Claim 25, Chomier shows the process as claimed as discussed in the rejection of Claim 21 above, but he does not show a specific reinforcing composition or physical property values thereof. However, it is well established that differences in concentration do not support patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. Further, where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation (See MPEP 2144.05 II (A)). Therefore, it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to select an appropriate reinforcing composition that allows for production of an article which satisfies particular end-use specifications.

Regarding Claim 26, Chomier shows the process as claimed as discussed in the rejection of Claim 22 above, including a method wherein the reinforcing material contains glass fiber (Column 5, lines 29-32).

Regarding Claim 27, Chomier shows the process as claimed as discussed in the rejection of Claim 22 above, but he does not show a specific reinforcing composition or physical property values thereof. However, it is well established that differences in concentration do not support patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. Further, where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation (See MPEP 2144.05 II (A)). Therefore, it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to select an appropriate reinforcing composition that allows for production of an article which satisfies particular end-use specifications.

Regarding Claim 28, Chomier shows the process as claimed as discussed in the rejection of Claim 18 above, including a method wherein the reinforcing

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frame parts are produced by means of injection molding while inserting a part of the base frame (Column 4, lines 45-64; Column 5, lines 1-8).

Regarding Claims 31-33, and 35-37, Chomier shows the process as claimed as discussed in the rejection of Claim 16 above, but he does not show specific configuration details of the bosses. However, it is noted that the structural configuration of the bosses is not interpreted as materially affecting the stepwise nature of the claim. To be entitled to weight in method claims, recited structural limitations must affect the method in a manipulative sense and not amount to mere claiming of a use of a particular structure (*Ex parte Pfieffer* 135 USPQ 31).

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chomier and Fujitani, in view of Hier et al. (U.S. Patent 6,568,707).

Regarding Claim 19, Chomier shows the process as claimed as discussed in the rejection of Claim 16 above, including showing that one frame part is more rigid than another (Column 3, lines 3-8). However, Chomier does not specifically show that the reinforcing frame part is higher in rigidity than the material of the base frame. Hier et al., hereafter "Hier," show that it is known to carry out a manufacturing method wherein the material of the reinforcing frame parts is higher in rigidity than the material of the base frame (Column 3, lines 62-67; Column 4, lines 1-4). Hier and Millif are combinable because they are concerned with a similar technical field, namely, molding processes which yield vehicle parts. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Hier's rigidity teachings in Chomier's molding process in order to obtain an article which has the appropriate structure to be useful in a vehicular environment.

Response to Arguments

Applicant's arguments with respect to claims 16 and 35-37 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica A. Huson whose telephone number is 571-272-1198. The examiner can normally be reached on Monday-Friday 7:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Monica A Huson

January 8, 2007



CHRISTINA JOHNSON
SUPERVISORY PATENT EXAMINER
1/8/07